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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,015	10/13/2000	Junying Yuan	00742/056003	7472

7590                    03/07/2002

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[REDACTED] EXAMINER

SMALL, ANDREA D SOUZA

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1626

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/688,015	YUAN ET AL.
	Examiner	Art Unit
	Andrea D Small	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 January 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-41 is/are pending in the application.

4a) Of the above claim(s) 3-8, 11-16, 26-31 and 38-40 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 2, 9, 10, 17-25, 32-37 and 41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

Applicant's amendments of paper no. 11, dated 01/08/2002, have been received and fully considered.

### *Applicants Amendments:*

- A. Pending Claims: 1-41
- B. Withdrawn Claims: 3-8, 11-16, 26-31 and 38-40 are withdrawn as being drawn to non-elected inventions, 37 CFR 1.142(b).
- C. Newly Added Claims: 41
- D. Amended Claims:
  - i. Claim 1, 9, 24 and 33 are amended.

Amendments to claims 1, 9 and 24 have overcome the rejections under 35 U.S.C. 112, first and second paragraph, outlined in paper no. 8, dated 05/30/2001.

### *Rejections*

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, **to make** and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-2, 9-10, 17-25, 32-37 and 41 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, **to make** the invention. Instantly, Applicant claims derivatives, pharmaceutical compositions and methods of using a chemical compound, namely compound ID # 115807. The specification does not provide

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an adequate description of the manner in which the derivatives are made. The steps, reagents, temperatures, pH, etc involved in making derivations of the compounds as claimed, their pharmaceutical compositions and their corresponding methods of use, is not provided. The limited disclosure, (see specification page 30), does not provide one of ordinary skill in the art a full, clear, concise and exact terms by which the claimed subject matter is made. By including a list of references, the rejections may be overcome. However, applicants should note that the introduction of new subject matter into the specification will raise the issue of new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 9-10, 17-25, 32-37 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1-2, 9-10, 17-25, 32-37 and 41: Claims 1, 9 and 24 contain the phrase "having" which renders the claim indefinite. It is not clear whether the Applicant is claiming more than just the compound depicted. Amending the claim to replace the word "having" with the word "of" is suggested to obviate the above rejection.

(b) Claims 24 and 41: Claims 24 and 41 contain the phrase "characterized by necrosis". This phrase is not defined in the claim or the specification such that one of ordinary skill in the art would be apprised of Applicants invention. Amending claim 24 to replace the phrase with "wherein decreasing necrosis is of benefit" is suggested to obviate the above rejection. Amending claim 41 to delete the phrase is suggested to obviate the above rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

*adsmall*  
Andrea D. Small

March 4, 2002

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